

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  14277US02									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>January 24, 2011</u>  Signature <u>/Francisco Castro/</u>  Typed or printed name <u>Francisco Castro</u>	Application Number  10/675,073		Filed  September 30, 2003								
	First Named Inventor  Jeyhan Karaoguz, et al.										
	Art Unit  2427		Examiner  Ryan, Patrick A.								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top;"><u>/Francisco Castro/</u> Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top;"><u>Francisco Castro</u> Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>64243</u></td><td style="vertical-align: top;"><u>773-573-7039</u> Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top;"><u>January 24, 2011</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	<u>/Francisco Castro/</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Francisco Castro</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>64243</u>	<u>773-573-7039</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>January 24, 2011</u> Date
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jeyhan Karaoguz, et al. Examiner: Ryan, Patrick A.

Application No. 10/675,073 Art Unit: 2427

Filed: September 30, 2003 Conf. No. 7513

For: **METHOD AND SYSTEM FOR MEDIA CHANNEL SETUP IN A MEDIA EXCHANGE NETWORK**

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**PRE-APPEAL BRIEF REQUEST ARGUMENTS**

This request is being filed with a Notice of Appeal and in response to the Final Office Action dated October 25, 2010 and the Advisory Action dated January 14, 2011. The present application includes pending claims 1-44, with claims 1, 11, 21, 32, 37 and 39 being the independent claims. All pending claims stand currently rejected.

**Rejections Under 35 U.S.C. §103**

Claims 1-44 stand rejected as being unpatentable over *Ellis et al.* (U.S. Patent 6,774,926), hereinafter *Ellis*, in view of *Moynihan* (U.S. Patent Application Publication 2002/0056119), and further in view of *Zustak et al.* (U.S. Patent Application Publication 2002/0104098), hereinafter *Zustak*. (See Final Office Action, pp. 4-32).

The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and the remarks provided below.

With respect to claim 1, the examiner states as follows:

The combination of *Ellis* and *Zustak* does not clearly demonstrate wherein said establishing said private television channel comprises receiving via a user interface at said first home a selection of one or more devices that are permitted to receive personal media via the private television channel, wherein said selected one or more devices include a device

associated with said second television and/or said second home.

(See *id.*, p. 6)(emphasis added by the examiner). The examiner then relies on *Moynihan* to overcome the above-admitted deficiency in *Ellis* and *Zustak*. (See *id.*). In this regard, the examiner alleges that *Moynihan* discloses “selecting viewers (2<sup>nd</sup> users) for the receipt of personal media created by a channel owner (1<sup>st</sup> user) from a user interface,” finding support in paragraphs 56, 88, and 89. (See *id.*, p. 7). The Applicant respectfully disagrees.

The Applicant submits that “selecting viewers for the receipt of personal media created by a channel owner from a user interface,” which the Examiner alleges is taught by *Moynihan*, is not equivalent to “**establishing said private television channel comprises receiving via a user interface at said first home a selection of one or more devices that are permitted to receive personal media via the private television channel,**” as recited by the Applicant in claim 1. No explanation or reason is provided as to why one would equate the limitation that is admittedly missing in *Ellis* and *Zustak* with the alleged teaching by *Moynihan* that is proposed by the examiner. For example, the examiner fails to show how the selection of viewers to receive media is in any way associated with “**establishing said private television channel,**” as recited in claim 1. In addition, selecting viewers to receive media is not the same or equivalent to receiving a selection of one or more devices that are permitted to receive media. Therefore, the Applicant submits that rejection of claim 1, and the reliance on *Moynihan* by examiner, is based on an incorrect interpretation of the language recited by the Applicant in claim 1.

Moreover, even if the interpretation proposed by the examiner were correct, which the Applicant does not concede, *Moynihan* does not disclose, teach, or suggest the admitted deficiency in *Ellis* and *Zustak*. In paragraph 56, *Moynihan* simply describes a software application, V-Mail, that when working with another software application, MediaMogul, both of which reside in the Internet/Network server shown in Figure 2, allows channel owners to publicize their software,

schedule broadcasts, and otherwise bring viewers to their channel by sending e-mails out with links to their channel, and therefore to the video available in their channel. Paragraphs 88 and 89 describe the use of contact lists for sending the e-mails and, in addition, moving video content from the server to e-mail boxes or personal computing devices of those viewers that are brought to the channel in response to the e-mails sent. Therefore, paragraphs 56, 88, and 89 do not disclose “**establishing said private television channel comprises receiving via a user interface at said first home a selection of one or more devices that are permitted to receive personal media via the private television channel,**” as recited by the Applicant in claim 1.

The examiner disagrees with the Applicant's arguments and states that “the Examiner does not exclusively rely on *Moynihan* to teach the Claim 1 step of ‘establishing said private television channel.’” (See Advisory Action, p. 3). The examiner further submits that *Moynihan* is used, in part, to teach “a user interface” and that it is the user interface that is not clearly established by *Ellis* and *Zustak*. (See *id.*). In this regard, the Applicant notes that claim 1 requires that the establishment of a private television channel comprises receiving the selection of one or more devices that are permitted to receive personal media through a user interface at a first home. Accordingly, the Applicant maintains that no motivation or suggestion is provided for using the software applications and/or the selection of viewers described in *Moynihan* to establish a television channel, let alone a private television channel. Instead, it appears that the examiner proposes combining *Ellis*, *Zustak*, and *Moynihan* out of impermissible hindsight.

With respect to *Moynihan*, the examiner further states:

*Moynihan* additionally demonstrates a user interface at said first home for selection of one or more devices permitted to receive personal media (Fig. 12 allowing the channel owner to control access to content based on a number of factors including IP address, as described in Paragraph [0085]; with further reference to Step E of Fig. 4 and the “black out” feature, as described in Paragraphs [0075-0076]).

(See Final Office Action, p. 7). The Applicant respectfully disagrees.

With respect to Figure 12 and paragraph 85, *Moynihan* merely indicates that the MediaMogul multimedia management program lets a user charge viewers to view content, password protect the content, hide content, or restrict access to content based on several criteria. Neither this section nor any other portion of *Moynihan*, however, discloses **“establishing said private television channel”** based on the ability of a user of the multimedia management program to control access to the content. Moreover, having a user control how and/or whether that user's content is accessed by viewers at the Internet/network server is not the same or equivalent to **“receiving via a user interface at said first home a selection of one or more devices that are permitted to receive personal media via the private television channel.”**

With respect to Step E and paragraphs 75 and 76, *Moynihan* simply describes information that is provided by the user when uploading content, some of which may be restriction information. The “blacked out” feature that the examiner points out is merely used at the Internet/Network server to restrict access to the content by geographic region, domain, or IP address. The “blacked out” feature is clearly not a selection of one or more devices permitted to receive media that is received through a user interface at a first home. Therefore, the Applicant submits that this portion of *Moynihan* also fails to disclose the subject matter recited by the Applicant in claim 1.

The examiner again disagrees with the Applicant's arguments and states that “[i]t is the Examiner's position that an IP address identifies a device and therefore *Moynihan*'s user interface functions to allow an end user to select one or more devices that are permitted to receive media.” (See Advisory Action, p. 3). Even if the examiner were correct, which the Applicant does not concede, the combination of *Ellis*, *Zustak*, and *Moynihan* fails to teach that a selection of IP addresses is received through a user interface at a first home as part of establishing a private television channel or any other like television channel.

Based at least on the reasons provided above, the Applicant submits that independent claim 1, and independent claims 11, 21, 32, 37 and 39, which are similar in various aspects to independent claim 1, are allowable over the proposed combination of *Ellis*, *Zustak*, and *Moynihn*. Moreover, claims 2-10, 12-20, 22-31, 33-36, 38, and 40-44, which depend from one of claims 1, 11, 21, 32, 37, and 39, are also submitted to be allowable. Consequently, the Applicant respectfully requests that the rejection of claims 1-44 under 35 U.S.C. §103(a) be withdrawn.

The Applicant also reserves the right to argue additional reasons beyond those set forth during prosecution and those provided below to support the allowability of claims 1-44, should such a need arise in the future.

### **CONCLUSION**

The Applicant respectfully submits that claims 1-44 of the present application are in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: January 24, 2011

Respectfully submitted,

/Francisco Castro/

Francisco Castro

Reg. No. 64,243

McAndrews, Held & Malloy, Ltd.  
500 West Madison Street, 34<sup>th</sup> Floor  
Chicago, IL 60661  
Tel.: (773) 573-7039  
Fax: (312) 775-8100